

### **III. REMARKS**

#### ***Claim Status***

Claims 1 and 6-26 are in the application and stand rejected. Claims 1, 19 and 23 have been amended. Claim 28-33 are newly presented.

The amended claims and new claims are in response to the examiner's rejection of the claims based on the phrase "catalytic proportions". Basis for these claims appears, as was previously pointed out to the examiner, at paragraph [0028] and [0010-11] of the published application.

#### ***Obvious Double Patenting***

Claims 1 and 6-26 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 10/653,863 (2004/0211333). Copending application USSN 10/653,863 (2004/0211333) has been abandoned, thus obviating this ground for rejection.

Claims 1 and 6-26 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-17 and 20 of copending Application No. 10/653,867.

Claims 1 and 6-16, and 23 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-17 and 20 of copending Application No. 10/526,644.

Applicant acknowledges these provisional rejections and will take appropriate action when the subject claims are otherwise deemed allowable.

***Claim Rejections - 35 USC § 102***

Claims **1-5, 17, 18, and 19** stand rejected under 35 U.S.C. 102(b) as being anticipated by Foster et al. (US 3,919,348).

As stated by the examiner, Foster et al. teach an epoxy-styrene solventless resin impregnation varnish, which is made by mixing (1) the product of the reaction of (a) 1 part of an epoxy resin mixture, (b) between about 0.01 to 0.06 part of maleic anhydride and (c) between about 0.0001 to 0.005 part of a catalyst with (2) a coreactive vinyl monomer and between about 0.00030 to 0.004 part of an aromatic acidic phenolic compound with (3) between about 0.3 to 1.2 part of a polycarboxylic anhydride which is soluble in the mixture of (1) and (2) at temperatures between about 0 to 35°C and an amount of free radical catalyst selected azo compounds and peroxide that is effective to provide a catalytic effect on the impregnating varnish to cure it at temperature over about 85°C.

As stated by the examiner in the office action, cycloaliphatic and acyclic aliphatic type epoxides may be used in Foster et al.'s composition and are generally prepared by epoxidizing unsaturated aliphatic or unsaturated aromatic hydrocarbon compounds, such as olefins and cyclo-olefins, using hydrogen peroxide or peracid.

Applicant traverses this ground for rejection.

Without agreeing or disagreeing with the examiner's statement, whether or not certain chemicals are required to prepare the components actually present in Foster's composition of Foster begs the question. It is what is present in Foster's composition that is relevant to the issue, not what was used to prepare the components present. And what may be present in Forster's composition are cycloaliphatic and acyclic aliphatic type epoxides. Cycloaliphatic and acyclic aliphatic type epoxides are not inorganic salts of peracids. They are not inorganic, they are not salts and they are not peracids.

Applicant respectfully requests reconsideration of this ground for rejection.

The examiner further cites the Foster reference as teaching that peroxide is used as a free-radical type high temperature catalyst for the polymerization reaction that may be present in the amount of 0.001 to 0.01 part for each part of combined solid-liquid epoxy resin and concludes that the composition as taught by Foster et al. appears to anticipate the claimed invention.

Applicant traverses this ground for rejection.

Applicant distinguishes the prior art of which Forster et al. is a part at paragraph [0010-11] of his published application, as follows:

[0010] Another aspect of the invention is a composition having a lithographic ink fountain solution including from 10 to 25,000 parts per million by weight of one ore more inorganic salts of peracids. The compositions can be any of those delineated herein

wherein the lithographic ink fountain solution concentrate includes from about 50 to about to 250,000 parts per million by weight of one or more inorganic salts of peracids.

[0011] In another aspect, the invention relates to composition that is a single fluid lithographic ink or varnish having from about 10 to about 25,000 parts per million by weight of one or more inorganic salts of peracids.

It is the substitution of inorganic peroxy acid salts for Foster's organic peroxides that is, *inter alia*, a basis for applicant's invention and a point which distinguishes applicant's compositions from those of Foster.

As Foster et al. does not disclose a composition containing inorganic peroxy acid salts the reference does not anticipate applicant's compositions.

Applicant respectfully requests reconsideration of this ground for rejection.

***Claim Rejections - 35 USC § 103***

Claims 1-24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Buckwalter (US 3,804,640).

As stated by the examiner, Buckwalter teaches a solvent-free printing ink comprising a metal salt of peroxydiphosphoric acid. The reference further teaches that the metal salt of peroxydiphosphoric acid is a catalyst that undergoes cleavage to form radicals. The reference remains silent to the type of

printing ink (i.e. lithographic). However it is the position of the Examiner that because the same components are taught as disclosed by Applicant that the ink could be used as a lithographic ink to be used in a lithographic method absence tangible evidence to the contrary.

Applicant traverses this ground for rejection.

Buckwalter is very specific in that the catalyst is restricted to metal salts of peroxydiphosphoric acid [col. 3, lines 3-5] and that the metal peroxydiphosphate is present in "about 1 weight percent to about 10 weight percent, and preferably about 3 weight percent to about 6 weight percent ..." [3, 31-33]

Applicant's catalyst is selected from many inorganic salts of peracids where "the inorganic salts of peracids are used in catalytic amounts (e.g., less than about 0.5 weight percent, less than about 0.25 weight percent, less than about 0.1 weight percent, based on total weight of the composition)." [paragraph [0028]

Thus, at the greatest amount, applicant's catalyst is utilized in amount of less than  $\frac{1}{2}$  the minimum amounts disclosed by Buckwalter. As Buckwalter is very clear in the amount of catalyst that is required, Buckwalter does not render applicant's composition obvious and in fact teaches away from applicant's composition.

Favorable reconsideration of this ground of rejection is respectfully requested.

***Examiner's Response to Arguments***

The examiner states that Applicant's arguments filed 8-30-07 are not persuasive because, as the examiner states "the features upon which applicant relies and which the references fail to show (i.e., Applicant's catalytic proportions) are not recited in the rejected claim(s).

Applicant respectfully disagrees.

The examiner acknowledges that the claims are interpreted in light of the specification but that limitations from the specification are not read into the claims citing *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The conclusion from this line of reasoning is that if limitations in the specification are in the claims, then the limitation must be considered in interpreting the claims.

Perhaps the examiner's argument would be persuasive if applicant did not define catalytic amount in his specification.

Claim 1 reads in pertinent part "and catalytic proportions of". As stated in applicant's last response, applicant's specification defines catalytic amounts:

Applicant's catalyst is selected from many inorganic salts of peracids where "the inorganic salts of peracids are used in catalytic amounts (e.g., less than about 0.5 weight percent, less than about 0.25 weight percent, less than about 0.1 weight percent, based on total weight of the composition)." [paragraph [0028]

Thus, the claim states catalytic proportions and the definition of catalytic proportions is set forth in the specification.

The examiner also acknowledges that applicant states that the references do not teach the catalytic proportions present in Applicant's claims. However, the examiner goes on to state that Applicant has not claimed a particular range therefore any amount that may be considered a catalytic proportion would read on the Applicant's claims.

Although the applicant would disagree, the examiner may object to this recitation as being indefinite under 35 USC 112, but it certainly is clearly outside the scope of the prior art references as stated in applicants last response, viz.:

Buckwalter is very specific in that the catalyst is restricted to metal salts of peroxydiphosphoric acid [col. 3, lines 3-5] and that the metal peroxydiphosphate is present in "about 1 weight percent to about 10 weight percent, and preferably about 3 weight percent to about 6 weight percent ..." [3,31-33].

This clearly leads away from the amounts specified by applicant.

Further, the statement by the examiner that "any amount that may be considered a catalytic proportion would read on the Applicant's claims" may or may not be a correct statement but even if it is correct, the amount specified by Buckwalter "about 1 weight percent to about 10 weight percent" is not what any

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chemist would consider a "catalytic amount". Therefore applicant reiterates the argument set forth in the previous response and requests favorable reconsideration.

***Conclusion***

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 50-3894.

Respectfully submitted,

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